

REMARKS

This is responsive to the Office Action dated 09/05/2006. Reconsideration is requested.

The claims now in the case are claims 1-10.

Amendment to paragraph 1 was indicated as being necessary. This amendment has been made.

The examiner is authorized to make additional amendments by Examiner's Amendment.

Claims 1-10 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is traversed.

Claims 1 and 5 were stated to be incomplete because the element for cleaning the dental instruments has not been recited. First, incomplete does not necessarily mean indefinite. The examiner apparently had no problem in determining the scope of the claims. Thus, it appears that the claims are not indefinite. The applicant regards devices containing no gauze as her invention. The claims have been amended to recite that the devices find use in the cleaning of dental instruments. That is, they may find use as such as in claims 4 and 6 or they may find use when combined with gauze as in claims 1 and 5. In either event, they find use in the cleaning of dental instruments. Should the examiner be inclined to maintain the rejection, the examiner is authorized to amend claims 1 and 5 so that the preambles read "a device comprising." The scope of the claims would be the same, but the intended use would not be apparent to one reading only the claims. Such an amendment would apparently overcome the examiner's problem.

Regarding claims 9 and 10, it was indicated that the term "the pointed end" lacked antecedent basis. It is considered that "pointed end" and "pointed tip" are one and the same. Since there is clear basis for "the pointed tip" there should be no question as to the antecedent basis for "the pointed end." Again, in the interest of advancing prosecution, should the examiner continue to value form over substance and insist on identical wording, the examiner is authorized to amend claims 9 and 10 to recite "the pointed tip."

Claims 1-8 are rejected under 35 USC 103(a) as being unpatentable over Wallock et al. in combination with Williams. Additionally, claims 9 and 10 were rejected under 35 USC 103(a) as being unpatentable over Cerroni in combination with Wallock et al. and Williams. It is applicant's position that if the rejection based on the Wallock et al. and Williams references is proper, then the rejection based on Cerroni, Wallock et al., and Williams references is proper. The converse is also true. Accordingly, in order to shorten this response, only the Wallock et al. and Williams references will be considered in depth. It will be assumed that claims 9 and 10 will assume patentability or unpatentability according to the patentability or unpatentability of claims 4 and 6, respectively.

The teachings of the Wallock et al. and Williams references relied on and the applications of these teachings to the claims are found on page 3 of the Office Action. The above rejections are traversed.

As the Examiner is aware, the four formal factual inquiries established in the Graham decision are used as a background in which to apply the three more substantive tests set forth in Section 2143 of the M.P.E.P.

The four factual inquires set forth in the Graham decision are as follows: (A) determining the scope and content of the prior art; (B) ascertaining the differences between the prior art and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations. The three basic requirements set forth in Section 2143 are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of the references, second, there must be a reasonable expectation of success, and third, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Each of these factors will be discussed below in order.

The first Graham factual inquiry is determining the scope and content of the prior art. It is applicants' position that the examiner has properly determined the scope and content of the cited prior art. The examiner has accurately stated what the prior art teaches. It is considered that the first Graham factual inquiry has been met.

The second Graham factual inquiry is ascertaining the differences between the prior art and the claims in issue. It is believed that this factual inquiry applies to only the primary reference. The examiner's attempt at this factual inquiry was to state the things which are not taught by the primary reference. This list is too short. It does not include the limitation of a textured exterior surface as called for by claim 2. It does not include the limitation that the device is made of flexible material which is called for by claim 7.

It does not include the limitation that the exterior surface is made of hard plastic and the interior surface of the open container is made of soft plastic as is called for by claim 8. Thus, it is considered that the second Graham factual inquiry has not been met.

The third Graham factual inquiry is resolving the level of ordinary skill in the pertinent art. The examiner has completely ignored this issue.

Regarding the necessity of determining the level of ordinary skill in the pertinent art, the comments of the CAFC are called to the attention of the examiner. The Fed. Cir. stated in the decision of Ryko Manufacturing Co. v. Nu-Star, Inc., 21 USPQ2d 1053, 1057 (Fed. Cir. 1991):

Appellant asserts legal error in the failure of the district court to resolve the level of ordinary skill in the art. The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry. Instead of ascertaining what was subjectively obvious to the inventor at the time of invention, the court must ascertain what would have been objectively obvious to one of ordinary skill in the art at such time. Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered. (Emphasis added.)

In order to apply an objective standard in determining the obviousness of applicant's invention, it is necessary that this determination be made by the examiner. This has not been done. Thus, the third factual inquiry required by the Graham decision has not been resolved.

The fourth Graham factual inquiry is evaluating evidence of secondary considerations. There is no such evidence in the present application.

The first basic requirement laid down by the M.P.E.P. is that there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to combine the teachings of the references. Regarding this basic requirement, the examiner stated that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the gauze taught by Williams in the Wallock et al. container to improve the cleaning. The suggestion or motivation for this substitution was that both references are from the same technical endeavor, which is cleaning medical instruments. The decision of In re Leavitt, 11 USPQ2d 1315 stands for the principle that it is well understood in patent law that the mere fact that two references originate from the same art area does not provide a teaching or suggestion to combine them. The examiner has not pointed to any teaching in any of the references which positively sets out this motivation. Therefore, this obviousness is assumed to be a result of some knowledge generally available to one of ordinary skill in the art. The examiner is called upon to present an affidavit described in 37 CFR 1.104(c)(3) setting forth clearly and precisely the facts which are available to those skilled in the art and which are relied upon by the examiner. In the absence of such an affidavit, it must be assumed that the examiner has not met the first requirement set out in the above-cited Section of the M.P.E.P.

The second basic requirement is that there must be a reasonable expectation of success resulting from combining the references. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The examiner does not point to any expectation of success found in the references. Note that in the primary reference the brushes are used to clean the instruments while in the secondary reference the allegedly equivalent gauze is used to

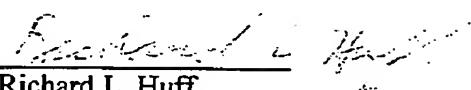
absorb a chemical reagent which is used to sterilize the instruments. There is no one-to-one functional equivalence between the brushes and the gauze.

The third basic requirement is that the prior art references must teach or suggest all the claim limitations. The claims call for a finger rest 4. The primary reference does not contain any such component. The claims call for a stem. The part of the primary reference which could come close to this part is the housing 17. The claims call for an open container having an exterior surface, an interior surface, and a top. This could be seen to correspond to the collar guard 45 of the primary reference. The claims call for a girth near the top. No component of the prior art resembles this part. The claims require that the interior surface contains prongs. The examiner first correctly states that the reference does not teach the prongs. The examiner next states that the prongs are inherent in the Wallock et al. cleaning apparatus. If the examiner takes the second position the examiner should point out where and how such prongs exist. Claim 4 requires that the container contains gauze. If the references are combined as envisioned by the examiner, any gauze would be in the stem (housing of the reference). Claim 7 requires that the device is made of flexible material. The device of the primary reference is rigid. Claim 8 requires that the exterior surface of the open container is made of hard plastic and the interior surface of the open container is made of soft plastic. There is no indication that the open container of the primary reference will be composed of two separate materials, not to mention the two types required by the claim. In view of the above, it is considered that the third basic requirement of the M.P.E.P. has not been met.

In view of the above it is believed that claims 1-10 are allowable, and a notice to that effect is solicited.

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Respectfully submitted,



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